

Remarks

Claims 1-28 are currently pending. Claims 1, 5-8, 16, 18, 20-21, 25 and 27 have been amended and claims 4, 11 and 15 have been cancelled. No new matter has been added. No new claims have been added. Applicants assert that all claims are in condition for allowance as set forth more fully below.

Interview Summary

The undersigned participated in a telephone interview with the Examiner on June 15, 2005. It was discussed that the selector switch on the alert generator was distinctly different from a jog dial located on the cellular phone body. It was further discussed that the ring signal from the body of the wireless device was fundamentally different from a current detector located in a separate ringing device. At the close of the interview, the Examiner requested that such clarifying arguments be submitted in writing.

Double Patenting Rejections

Claims 1-28 have been provisionally rejected for obvious type double-patenting over claims 1-20 of App. 09/964,385 and over claims 1-20 of App. 10/101,630. As this is a provisional rejection since none of the claims have yet to be patented, Applicants assert that a terminal disclaimer would be premature and reserve the right to respond to such double patenting rejections in the future upon such claims being patented.

Claim Objections

Claims 1, 6, 18, 21 and 25 stand rejected due to the lack of formalities. Claims 1, 6, 18, and 25 have been amended to read “communication” instead of “communications” and claim 21 has been amended to read “a telephone” instead of “the telephone”. It is respectfully suggested that the cited claim objections can now be withdrawn.

102 Rejections

Claims 1-3, 5-10, 12-14, 16-19 and 21-24 stand rejected under 35 USC §102(b) as being anticipated by Stone et al (US Pat 5,767,778). Independent claims 1, 5, 6, 7, 18,

20-21, 25 and 27 now recite elements not disclosed by Stone. Namely, each of these amended claims recites at least one feature function of step not disclosed by the cited reference, singly or in combination.

Claims 1-4, 7-19, 21, and 24

The Office Action rejects independent claims 1, 7 and 18 by stating that Stone teaches all of the elements. The Office Action concedes on page 9 that Stone contains all the recited elements except a user interface on the shell of the alert signal device for scrolling through the plurality of sound files and designating a sound file to use as an audio alert signal. Applicants concur with that assessment. Amended claims 1, 7, 18, and 21 recite, in pertinent part, a selector device on the shell (or alert signal device) for scrolling through the plurality of sound files and designating a sound file to use as an audio alert signal by moving the subject matter from dependent claims 4, 11 and 15. As such, independent claims 1, 7, 18, and 21 are now allowable over Stone because Stone does not disclose a selector on the shell. Should the Examiner disagree, Applicants request that the Examiner specifically point out the selector of Stone on the ringing device. Dependent claims 2-3, 7-10, 12-19 and 24 depend from allowable claims 1, 7 and 18 and are also allowable over Stone for the same reasons.

Claims 5, 6 and 21-23

The Office Action rejects independent claims 5, 6 and 21 by stating that Stone teaches all of the elements. The Office Action equates the current sensor **35**, voltage drop resistor **50** or Magnetic Field Sensor (Col. 6, l. 1-5) in Stone to the signal from the wireless communication device body recited in the claims. However, it should be noted that there are several differences between what Stone teaches and the claims.

Amended claims 5, 6 and 21 recite that the alert (or sound) generating device is triggered by an electrical signal from the wireless communication device body. These recitations are contrary to Stone.

Stone teaches the use of a current or power sensor (Col. 2, l. 1-45) sensing telephone activity to trigger an alert generator. This sensing circuit is located in the alert generator (Figs. 4 and 5) which in turn is located either in the battery or in an add on

interconnection package (Abstract; Col. 2, l. 35-55) which is then in turn connected within a telephone/device housing. Stone does not teach the sensing circuit being located in the body of the communication device nor does it teach the alert generator being triggered by an electrical signal from the wireless communication device body. Thus Stone is not concerned with an alert generator outside the body of a wireless communication device being triggered by an electrical signal from the wireless device and therefore fails to teach the recitations of the amended claims.

Accordingly, for at least these reasons, claims 5, 6 and 21 are allowable over Stone. Dependant claims 22-24 depend from an allowable claim 5, 6 or 21 and are also allowable for at least the same reasons.

103 Rejections

Claims 4, 11, 15, 20 and 25-28 stand rejected under 35 USC §103(a) as being unpatentable over Stone in view of either Haraguchi (US Pat. 6,597,279) or Sawada (US Pat 6,810,274). Applicants respectfully traverse these rejections.

Claims 5, 6, 20, 22 and 23

Claims 4, 11, 15 and 20 stand rejected under 35 USC 103(a) as being unpatentable over Stone in view of Haraguchi. Claims 4, 11 and 15 have been cancelled and their subject matter has been moved into claims 1, 7 and 18. Amended independent claims 1, 7, 18 and 20 contain elements not disclosed by the combination of these references. As mentioned above, the Office Action concedes that Stone fails to teach a user interface on the shell for scrolling through the plurality of sound files and designating a sound file to use as an audio alert signal and Applicant concurs with that assessment.

Claims 1, 7 and 18 now recite a selector device on the alert signal device for scrolling through a plurality of sound files and designating a sound file to use as an audio alert signal and Claim 20 now similarly recites a selector located on an outside surface of the alert signal device, wherein the alert generating device includes a plurality of alert files.

The Office Action has stated that Haraguchi teaches a method for “setting an

incoming tone . . . comprising a jog dial for scrolling through the plurality of sound files and designating a sound file” (Col. 5, l. 16- Col 6, l. 34). However, it is evident that Haraguchi discloses the use of a jog dial 9 on the front outer surface of the pager (Fig. 2, 1a) and not on the surface of an add-on alert generator. Stone teaches an alert generator in a replacement battery or add-on device (Col. 21. 1-5) but has no selector switch on the alert generator to scroll through alert files. There is no teaching or suggestion in either reference to combine a jog dial with an add-on alert generator such that this element of the claims is missing from the cited combination.

A reference must provide an explicit or implicit suggestion, teaching or motivation in order to be §103 prior art. (See, *In Re Dembiczak*, 175 F.3d 994, 50 U.S.P.Q.2D (BNA) 1614 (Fed. Cir. 1999) (Placing a pumpkin face on an orange trashbag not obvious under 35USC§103 without finding of suggestion, teaching or motivation in the reference). Those teachings must also have a reasonable chance at success (See, *Brown & Williamson Tobacco Corp. v. Phillip Morris, Inc.*, 229 F.3d 1120, 56 U.S.P.Q.2D (BNA) 1456 (Fed. Cir. 2000). Furthermore, an argument based on the theory that “it was obvious to try” fails as an obviousness rejection. *In re Fine*, 837 F.2d 1071, U.S.P.Q.2D 1596 (Fed. Cir 1988).

Accordingly, independent claims 5, 6 and 20 are allowable for at least these reasons. Dependent claims 22 and 23 depend for allowable claim 5 or 6 and are allowable for at least the same reasons.

Claims 25-28

Claims 25-28 stand rejected under 35 USC 103(a) as being unpatentable over Stone in view of Sawada. Amended independent claims 25 and 27 contain elements not disclosed by the combination of these references. Claims 25 and 27 now recite a selector device on the outside surface of the shell for scrolling through the plurality of sound files and designating a sound file to use as an audio alert signal.

As discussed above, the Office Action concedes that Stone fails to teach a user interface on the shell for scrolling through the plurality of sound files and designating a sound file to use as an audio alert signal and Applicant concurs with that assessment. It is also apparent that Sawada also does not teach a user interface on the outside surface of

the shell of the alert generator for scrolling through the plurality of sound files and designating a sound file to use as an audio alert signal (Fig. 2, 7; Fig. 6, 26, Col 3, l. 15-21; Col. 4, l. 33-40). If neither reference teaches a selector on the shell, then the combination of Stone and Sawada does not teach or provide the suggestion to place a selector on the surface of the shell for scrolling through a plurality of sound files. As such, independent claims 25 and 27 are therefore allowable over Stone in view of Sawada. Dependent claims 26 and 28 depend from allowable claims 25 and 27 and are therefore also allowable for at least the same reasons.


Conclusion

Claims 1-28 are pending, claims 1, 5-8, 16, 18, 20-21, 25 and 27 have been amended and claims 4, 11 and 15 have been cancelled. Applicants request reconsideration based these amendments and arguments. Should the Examiner have any questions, please contact the undersigned.

No fees are believed due. However, please charge any additional fees or credit any overpayment to Deposit Account No. 50-3025.

Respectfully submitted,

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